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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/153,644    09/15/98    DOBBS

S    05015.0175

NEEDLE & ROSENBERG  
SUITE 1200 THE CANDLER BUILDING  
127 PEACHTREE STREET NE  
ATLANTA GA 30303-1811

HM12/0509

EXAMINER

MCQUEENEY, P

ART UNIT

PAPER NUMBER

1615

DATE MAILED:

05/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.

09/153,644

Applicant(s)

DOBBS ET AL.

Examiner

P. E. McQueeney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2001.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

### **DETAILED ACTION**

1. Acknowledgement is made of applicants' request for reconsideration filed February 21, 2001.

### ***Response to Arguments***

2. Applicants' arguments filed February 21, 2001 have been fully considered but they are not persuasive.

### ***Claim Rejections - 35 USC § 102***

3. Claims 1-5, 8, 10-12, 14, 15, 27-38 and 43-47 were rejected under 35 U.S.C. 102(b) as being anticipated by Madrange nee Dermain et al. (US 4,173,627). Madrange nee Dermain et al. disclose claims 1, 30-32, 34 and 43 of applicant's invention in claims 1, 6 and 7 and at column 3, lines 37-52. Madrange nee Dermain et al. disclose claims 2, 3, 35, 36, 44 and 45 of the present invention in claim 9 and col. 3, lines 48-52. Madrange nee Dermain et al. disclose claims 4 and 5 of the present invention in col. 4, line 28 through col. 5, line 8. Madrange nee Dermain et al. disclose claims 8, 10 and 11 of the present invention in claims 1 and 4. Madrange nee Dermain et al. disclose claim 12 of the present invention in claim 4 and Example 2. Madrange nee Dermain et al. disclose claims 14, 15, 33, 37, 38 and 46 and 47 of the present invention in claim 1, 3, 9 and col. 3, lines 48-52. Madrange nee Dermain et al. disclose claim 27 of the present invention in claim 8. Madrange nee Dermain et al. disclose claims 28 and 29 of the present invention in claim 8 and col. 4, lines 18-28.

Applicants argue that Madrange nee Dermain *et al.* do not disclose a hair care composition comprising both ethanol and methyl acetate or comprising isopropanol and methyl acetate. Examiner directs applicants to col. 3, lines 37-52 which provides that the liquid phase of the invention of Madrange nee Dermain *et al.* comprises 0-94% ethanol or isopropanol and 0-25% methyl acetate. Applicants are directed to MPEP 2123 – Patents are Relevant as Prior Art for All They Contain. “Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiment.”

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that Madrange nee Dermain *et al.* do not include t-butyl acetate in their composition) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

This rejection is maintained as to claims 1-5, 8, 10-12, 14, 15, 27-38 and 43-47.

4. Claims 1, 2, 8-10, 16, 17, 31-35, 37, 39-44 and 46 were rejected under 35 U.S.C. 102(b) as being anticipated by Heeb *et al.* (US 4,243,548). Heeb *et al.* disclose a pressurised aerosol formulation. Heeb *et al.* disclose claims 1, 8-10, 16, 17, 31-35, 37, 39, 40, 43, 44 and 46 of the present invention in claims 1-11; col. 3, lines 3-7 and example 15. Heeb *et al.* disclose claim 2 of the present invention in claims 1-11; col. 3,

lines 3-7 and 40-48 and example 15. Heeb et al. disclose claims 41 and 42 in claims 1-11 and col. 3, lines 3-7 and the examples.

Applicants argue that Heeb *et al.* do not disclose a hair care composition comprising both ethanol and methyl acetate or comprising isopropanol and methyl acetate. Examiner directs applicants to claim 1 which claims "...wherein said organic solvents are selected from the group consisting of .... ethyl alcohol, n-propanol, isopropanol, methyl acetate, ... and mixtures thereof." This reads directly on applicants' claims.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that Heeb *et al.* do not include t-butyl acetate in their composition) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

This rejection is maintained as to claims 1, 2, 8-10, 16, 17, 31-35, 37, 39-44 and 46.

### ***Claim Rejections - 35 USC § 103***

5. Claims 1-40 and 43-48 were rejected under 35 U.S.C. 103(a) as being unpatentable over Madrange nee Dermain et al. as discussed above.

Madrange nee Dermain et al. do not explicitly include water in their disclosure. However, since Madrange nee Dermain et al. do not disclose that the ethanol must be

absolute or denatured ethanol, it would be obvious to one of ordinary skill in the art at the time of the invention to use ethanol that is not absolute or denatured with the motivation that the ethanol that is not absolute or denatured may be more readily available or cheaper. Such ethanol contains about 5% water.

The amounts of the water is considered a manipulatable parameter that would be obvious to one skilled in the art in an effort to provide a suitable solvent.

Madrang nee Dermain et al. do not explicitly disclose 1,1-difluoroethane. Madrang nee Dermain et al. does disclose difluoroalkane. It is the position of the examiner that the specific alkane is a limitation that would be routinely determined by one of ordinary skill in the art through minimal experimentation as being suitable absent the presentation of some unusual or unexpected results. The results must be those that occur from the specific limitations.

Madrang nee Dermain et al. do not disclose a method of fixing hair. In the absence of criticality, it is the position of the examiner that the spraying of hair spray onto hair is a well-known method available on any bottle of hair spray.

Applicants argue that Madrang nee Demain *et al.* do not include t-butyl acetate again. Applicants' claim recites "methyl acetate and/or t-butyl acetate." The claim can be interpreted "methyl acetate," "t-butyl acetate," or "methyl acetate and t-butyl acetate." The reference discloses methyl acetate. Therefore, the claim is anticipated based on the methyl acetate.

Applicants again argue that none of the examples of Madrang nee Demain *et al.* disclose a combination of ethanol or isopropanol with ethyl acetate. As stated above,

"[d]isclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiment."

This rejection is maintained as to claims 1-40 and 43-48.

6. Claims 1, 2, 8-10, 16, 17, 31-35, 37, 39-44 and 46 were rejected under 35 U.S.C. 103(a) as being unpatentable over Heeb et al. as discussed above.

Heeb et al. disclose isopropanol in example 15. Applicant's claims directed to ethanol would have been obvious to the skilled artisan because the close structural similarity of the reference compound suggests the claimed compound. One skilled in the art would expect the two compounds to have similar properties.

Applicants arguments with regard to t-butyl acetate and the combination argument are discussed above.

This rejection is maintained as to claims 1, 2, 8-10, 16, 17, 31-35, 37, 39-44 and 46.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. E. McQueeney whose telephone number is 703-306-5827. The examiner can normally be reached on M, T, H, F 7:45 AM to 6:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3592 for regular communications and 703-308-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

pem  
May 1, 2001

THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600